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MAILED

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OFFICE OF PETITIONS

In re Application of :  
Blonder et al. : DECISION ON APPLICATION  
Application No. 09/888,235 : FOR PATENT TERM ADJUSTMENT  
Filed: 06/22/2001 :  
Atty Docket No. 42830-00234 :

This is a decision on the "APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed February 22, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected to one thousand four hundred eighty-nine (1,489) days.

The application for patent term adjustment is DISMISSED.

On January 7, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 1,260 days. On February 22, 2010, applicants timely submitted the instant application for patent term adjustment<sup>1</sup>. Applicant states that no terminal disclaimer was filed in this application.

On petition, applicants assert that they are entitled to 37 days of Office delay pursuant to 37 CFR 1.702(a)(2). Specifically, applicants explain:

It is submitted the Office Action issued by the United States Patent and Trademark Office (USPTO) on 1/28/2004 should not be considered as a response to a reply under 35 U.S.C. §132, pursuant to §1.702(a)(2), because that

<sup>1</sup> The Office records show that the issue fee was received on April 5, 2010.

Office Action was deficient and was expressly vacated in a new Office Action issued 4/5/2004. See, the 4/5/2004 Office Action and accompanying Interview Summary.

*Petition, 02/12/10, p. 3.*

The Office has considered applicants' argument, but does not find it persuasive. Pursuant to 37 CFR 1.702(a),

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

On January 28, 2004, the examiner responded to applicants' reply to the final Office action filed on October 28, 2003. The non-final Office action of January 28, 2004, met the minimum requirements of an action under 35 U.S.C. 132 and was mailed within four months of the October 28, 2003 filing date of the reply. Accordingly, no period of adjustment for Office delay was entered. A review of the record confirms that no period of adjustment for Office delay is warranted.

The subsequent mailing of the non-final Office action by the examiner vacating the Office action of January 28, 2004, does not negate the fact that the Office took action in this application within the meaning of § 1.702(a)(2) on January 28, 2004. Specifically, the Office notes that an examiner does not have the authority to vacate or rescind an Office action. Unless vacated by the Technology Center Director, the action originally mailed by the examiner on January 28, 2004, will be used for purposes of calculating patent term adjustment.

Next, applicants assert that the period of adjustment under 37 CFR 1.702(e) should be 1,695 days, not 1,503 days. Applicants state:

It is submitted the Notice of Appeal filed 8/23/2005 should not be considered as the beginning of the appeal

period under §1.703(e) for purposes of the adjustment under §1.702(e) because that Notice of Appeal was filed only to maintain a previously filed appeal following issuance by the Examiner of an Office Action while the application was on appeal and which was not responded to. The period of delay due to appeal under § 1.702(e) should, therefore, be measured from the original Notice of Appeal filed on 4/21/2005.

*Petition, 02/12/10, p. 3.*

The Office has considered applicant's argument, but finds it without merit. The mailing of the non-final Office action on June 27, 2005, withdrew the finality of the rejection and re-opened prosecution of the application. Accordingly, the application was no longer under appeal and applicant had to file a new notice of appeal in order to appeal to the Board for review of the examiner's rejections. Thus, the Office correctly calculated the period of adjustment under 37 CFR 1.702(e) beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31, October 31, 2005, and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences, December 11, 2009.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance will remain 1,260 days.

The \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

A handwritten signature in black ink, reading "C. T. Donnell". The signature is written in a cursive, flowing style.

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions